

REMARKS

The Office Action

Claims 12-16 and 19 are pending and examined in the present Office Action. Claims 13-16 are allowed. Claim 12 is objected to for containing non-elected subject matter. Claim 19 is rejected under 35 U.S.C. § 112, first paragraph for lack of enablement. Applicants address each of these rejections below.

Pending Claims

With this reply, claim 12 is canceled and claim 21 is added. Claims 15 and 16 have been amended. Claim 19 has been amended to specify a method of preventing programmed cell death. Support for the amendments can be found throughout the specification and the claims. For example, the amendment to claim 19 can be found on page 2, lines 12-17, page 9, lines 6-13, and on page 47, lines 5-17. No new matter has been added by these amendments.

Information Disclosure Statement

The Office acknowledges receipt of the Information Disclosure Statement filed on February 25, 2002, but indicates that it has not considered the references contained therein because the Office was not provided with a legible copy of each reference listed in the accompanying Form PTO-1449. Applicants note that, under 35 U.S.C. § 120, this application relies on the earlier filing date of application serial number 08/394,189, filed on February 24, 1995. The references submitted to the Office in the present Information Disclosure Statement were previously submitted to and/or cited by the Office in the prior application. Therefore, according to 37 C.F.R. § 1.98(d), copies of these references are not required. Applicants respectfully request that the present references now be considered. If there is a remaining issue with the Information Disclosure Statement, the Examiner is requested to call the undersigned attorney at (617) 428-0200.

Objection to the Specification

The Office objects to the title of the invention as failing to meet the standard set forth by 37 C.F.R. § 1.72(a) and M.P.E.P. § 606. In response to this objection, the title of the invention has been amended to “ALTERED HUMAN INTERLEUKIN-1 β CONVERTASE (ICE), NEDD-2, AND C. ELEGANS CED-3 POLYPEPTIDES AND USES THEREFOR.” Applicants submit that this amendment overcomes the objection to the specification and may be withdrawn.

Claim Objections

Claim 12 is objected to because it contains non-elected subject matter. This claim is cancelled and this objection may now be withdrawn.

Rejection under 35 U.S.C. § 112, first paragraph

Claim 19 stands rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. The Examiner states that claim 19 “reads on preventing all cell death, regardless of the condition of the patient” and that “the scope of the instant claim is not commensurate with the enablement of the instant disclosure, because practice of the claimed invention means that it is possible to prevent cell death completely.” As an example, the Examiner asserts that cell death caused by cancer cannot be prevented by the administration of a protein from claim 13.

While Applicants do not agree with the Office’s basis for the current § 112, first paragraph rejection, Claim 19 has been amended to read “A method for preventing programmed cell death, wherein said method comprises administering to a patient the protein of claim 13 at a therapeutically effective dose” (emphasis added). Applicants submit that this amendment clarifies that administration of a protein of claim 13 prevents programmed cell death, and not the death of cells generally.

Applicants submit that the rejection of claim 19 has been overcome by the present claim amendment and request that the rejection be withdrawn.


CONCLUSION

Applicants submit that the claims are now in condition for allowance, and such action is respectfully requested. Enclosed are a petition to extend the period for replying for one month, to and including November 1, 2004, and a check for \$55.00 for the required petition fee. If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date:

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